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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CHRISTOPHER L. PARMELEE and MARK D. SMITH

Appeal 2008-2907
Application 09/683,943
Technology Center 2400

Decided:¹ March 19, 2009

Before JAMES D. THOMAS, JOSEPH L. DIXON, and
ST. JOHN COURTENAY III, *Administrative Patent Judges*.

DIXON, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

I. STATEMENT OF THE CASE

A Patent Examiner rejected claims 1-41. The Appellants appeal therefrom under 35 U.S.C. § 134(a). We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

A. INVENTION

The invention at issue on appeal relates to automated transaction machine digital signature system and method. (Spec. 1.)

B. ILLUSTRATIVE CLAIM

Claim 1, which further illustrates the invention, follows.

1. An apparatus comprising:
at least one computer processor; and
at least one data store in operative connection with the computer processor, wherein the at least one data store includes a plurality of digital safe deposit accounts stored therein, wherein each of the digital safe deposit accounts is associated with at least one private key, wherein the computer processor is operative to communicate with a plurality of ATMs, wherein the computer processor is operative responsive to at least one of the ATMs to cause a digital signature to be produced for an electronic document responsive to the private key associated with one of the digital safe deposit accounts.

C. REFERENCES

The Examiner relies on the following references as evidence:

Randle	5,974,146	Oct. 26, 1999
Cohen	WO 00/55793	Sep. 21, 2000
Wheeler	US 2002/0026575 A1	Feb. 28, 2002
Meurer	US 2004/0215566 A1	Oct. 28, 2004

(filed Nov. 14, 2001)

Wheeler Provisional Application (relied upon for priority date)	US 60/223,076	Aug. 4, 2000
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D. REJECTIONS

The Examiner makes the following rejections.

Claims 1-6, 8-11, 15-16, 19, 27-30, 33-39, and 41 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Wheeler and further in view of Cohen.

Claims 7, 12-14, and 40 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Wheeler and Cohen and further in view of Randle.

Claims 17-18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Wheeler and Cohen, and further in view of Meurer.

Claims 20-21, 23, 25-26, and 31-32 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Wheeler.

Claim 22 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Wheeler in view of Cohen as applied to claim 20 above, and further in view of Randle.

Claim 24 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Wheeler as applied to claim 20 above, and further in view of Meurer.

II. ISSUE

The Examiner finds that the Wheeler provisional application provides ample support for those selected portions of the Wheeler published application relied upon by the Examiner in the rejections.

Since the Wheeler published application is relied upon for obviousness rejections, its qualification as prior art is therefore necessary to this appeal. Accordingly, the pivotal issue before us is whether Appellants have shown that the Examiner erred in relying on the Wheeler published application as prior art under § 102(e). This issue turns on whether the critical reference date of the Wheeler published application is the filing date of its underlying provisional application. In this regard, our resolution of the pivotal date issue will also be dispositive of the majority of Appellants' arguments with respect to each of the argued claims.

If the Wheeler published application qualifies as prior art, we then address the second issue that pertains to the obviousness rejections, namely whether Appellants have shown that the Examiner erred in combining the teachings of the Wheeler published application with Cohen, Randle, and Meurer.

III. PRINCIPLES OF LAW

35 U.S.C. § 103(a)

Section 103 forbids issuance of a patent when “the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.”

KSR Int'l Co. v. Teleflex Inc., 127 S. Ct. 1727, 1734 (2007).

In *KSR*, the Supreme Court emphasized "the need for caution in granting a patent based on the combination of elements found in the prior art," *Id.* at 1739, and discussed circumstances in which a patent might be determined to be obvious. *KSR*, 127 S. Ct. at 1739 (citing *Graham v. John Deere Co.*, 383 U.S. 1, 12 (1966)). The Court reaffirmed principles based on its precedent that "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *Id.* The operative question in this "functional approach" is thus "whether the improvement is more than the predictable use of prior art elements according to their established functions." *Id.* at 1740.

The Federal Circuit recently recognized that "[a]n obviousness determination is not the result of a rigid formula disassociated from the consideration of the facts of a case. Indeed, the common sense of those skilled in the art demonstrates why some combinations would have been obvious where others would not." *Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1161 (Fed. Cir. 2007) (citing *KSR*, 127 S. Ct. 1727, 1739 (2007)). The Federal Circuit relied in part on the fact that Leapfrog had presented no evidence that the inclusion of a reader in the combined device was "uniquely challenging or difficult for one of ordinary skill in the art" or "represented an unobvious step over the prior art." *Id.* at 1162 (citing *KSR*, 127 S. Ct. at 1740-41).

One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986).

IV. ANALYSIS

At the outset, we note that in Appellants' Brief Appellants argue the prior art references as applied by the Examiner and address the merits of the Wheeler published application, but in Appellants' Reply Brief, filed July 31, 2007, Appellants address the merits of the Wheeler provisional application (which is not the prior art applied against the claims). Therefore, we find Appellants' arguments in the Reply Brief concerning the Wheeler provisional application, which is not the prior art applied against the claims, do not show error in the Examiner's application of the Wheeler published application. From our review of the totality of the Wheeler provisional application, we find ample support for those portions of the Wheeler published application which were relied upon in the rejection to entitle those portions of the published application to the filing date of the provisional application filed under 35 U.S.C. § 111(b). 35 U.S.C. § 119(e)(1) states:

An application for patent filed under section 111(a) or section 363 of this title for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in a provisional application filed under section 111(b) of this title, by an inventor or inventors named in the provisional application, shall have the same effect, as to such invention, as though filed on the date of the provisional application filed under section 111(b) of this title, if the application for patent filed under section 111(a) or section 363 of this title is filed not later than 12 months after the date on which the provisional application was filed and if it contains or is amended to contain a specific reference to the provisional application.

We find ample support under 35 U.S.C. § 112 for those portions of the Wheeler published application in the Wheeler provisional application to support both enablement and written description requirements. While the format of the Wheeler provisional application is in the form of four separate

communications and does not appear as polished of a publication as the published application, we find the well-known and general teachings relied upon by the Examiner in the Wheeler published application are clearly evidenced within these four separate communications when read together. Furthermore, the Examiner has provided in-depth correlations of the relied upon portions of the Wheeler published application to the Wheeler provisional application in the Answer. We find the Examiner's correlations to be well-founded and supported by substantial evidence.

From our review of Appellants' arguments throughout the Brief, we find that Appellants' arguments generally recite two portions of the claimed invention, which the Examiner individually relies upon each of the two references for a portion thereof. Appellants then maintain that neither the Wheeler reference nor Cohen reference teach or suggest these combined limitations. We do not find these arguments to be persuasive of the error in the Examiner's initial showing of obviousness since the Examiner has relied upon each reference for only a portion of the asserted limitations. Hence, each reference would not have taught nor suggested the combination of limitations. The Examiner's rejection is based upon what the combined teachings of the two references, which are in related fields of electronic banking, would have fairly suggested to one of ordinary skill in the art.

In the Brief, we do not find Appellants' arguments address the Examiner's rejection as set forth in the present administrative record. Here, Appellants' arguments generally address each reference's individual contribution rather than what the prior art as a whole would have taught or fairly suggested to those skilled in the relevant art of electronic banking and related banking services.

The Examiner's rejection is generally based upon general teachings found in the Wheeler published application, which we find to be supported by the Wheeler provisional application with respect to these well-known facets of the use of automated teller/transaction machines (ATMs) and security concerns that are addressed by public/private key encryption methodologies and with certification technology. In a related field of online electronic commerce and electronic banking, Cohen teaches that additional banking services, such as, safe deposit accounts (which we find to be similar to safe deposit boxes/lockboxes in traditional banking) for storage of electronic documents were desirable for patrons who used electronic banking and electronic transactions. Thus, we agree with the Examiner that those skilled in the art would have readily combined the teachings of Wheeler and Cohen.

A similar issue relying upon a domestic priority date to a provisional application was recently addressed in a precedential opinion by the Board of Patent Appeals and Interferences in *Ex parte Yamaguchi*, <http://www.uspto.gov/web/offices/dcom/bpai/prec/fd074412.pdf>, slip op. at 17 (BPAI Aug. 29, 2008) (precedential) (“In sum, the statutory scheme of Title 35 indicates that Congress intended for “applications for patent” under 102(e) to apply to both regular utility applications and provisional applications, particularly when considering §§ 111(b) and 102(e) together. As a published “application for patent” under this statutory framework, *a provisional application — like a regular utility application — constitutes prior art for all that it teaches* and, as such, promotes the progress of the useful arts.”) (Emphasis added). In *Yamaguchi* at 18, the Board found that when the Examiner's factual finding that both documents (published

application and provisional application) clearly shows the same subject matter as applied in the rejection, then the Examiner has shifted the burden to Appellants to show why such a factual finding is in error.

Here, Appellants contend at page 17 of the Brief that the specification of the Wheeler provisional application is not identical to the specification of the Wheeler published application. Appellants contend that the paragraphs relied upon in the Wheeler published application are not included in the Wheeler provisional application. Appellants further contend that those portions of the Wheeler provisional application listed in the Office action do not disclose or suggest all the features recited in Appellants' claims against which the Wheeler publication was cited. Appellants therefore contend that the Wheeler provisional does not support the allegedly relevant portions of the Wheeler publication that were cited by the Office action to support the rejection of the claims. (App. Br. 17-18).

Appellants further contend that the Wheeler provisional application contains insufficient disclosure to teach one skilled in the art, at the date of filing, how to make and used the full scope of the alleged inventions shown in the Wheeler publication without undue experimentation. Appellants contend that the Wheeler provisional application as a whole does not provide an enabling system or method. (App. Br. 18). Hence, Appellants maintain that the Wheeler published application is not entitled to the August 4, 2000 filing date of the non-enabling Wheeler provisional application. Therefore, Appellants contend that the Wheeler published application at best is only entitled to the August 6, 2001 filing date of the Wheeler published application. We disagree with Appellants' contentions, as discussed above.

With respect to independent claim 1, the Examiner relies upon the portions of the Wheeler published application to show the well-known concept of the use of a plurality of ATMs connected to at least one computer processor and at least one data store, wherein the at least one data store includes a plurality of digital accounts. Additionally, the Examiner relies upon the teachings of the Wheeler published application to show the well-known use of public/private encryption keys for security and safety of the data. The Examiner also relies upon the Wheeler published application to show and evidence an electronic document responsive to private key associated with one of the digital accounts.

We find the Examiner's correlation of the teachings of the Wheeler provisional application to the Wheeler published application to amply support these limited teachings, which we additionally find were well-known for ATM machines, at the time of the present invention. For the extension of these teachings of the Wheeler published application to electronic documents which are then stored in an electronic safety deposit box/account, the Examiner turns to Cohen which is directed to electronic commerce, particularly in the field of electronic banking. (Ans. 8-9). The Examiner further provides a line of reasoning for the motivation for the combination — that Cohen suggests using an electronic safety deposit box/account for quick and authenticated access to important user documents/records. (Ans. 9). We find the Examiner's stated motivation to be compelling since Cohen attempts to provide additional electronic services that bank patrons would normally receive from traditional physical banks/institutions.

From our review of the teachings of the Wheeler published application (and the Wheeler provisional application) and the teachings of Cohen, we find ample support for the Examiner's finding of obviousness of the invention as recited in independent claim 1. Therefore, we look to Appellants' Briefs to identify any error in the Examiner's initial showing of obviousness.

With respect to independent claim 1, Appellants additionally argue that independent claim 1 recites "each of the digital safe deposit accounts is associated with at least one private key." (App. Br. 21).

The Examiner (at pages 8-9 of the Answer) identifies paragraph [0109] of the Wheeler published application wherein a private/public key are associated with an account, and when in combination with the teachings of Cohen, then the account would have further included a digital safe deposit account. Therefore, the combination would have taught and fairly suggested the claimed limitation. Therefore, we find Appellants' argument unpersuasive of error in the Examiner's initial showing of obviousness.

Appellants further argue that the teachings of Wheeler at paragraph [0113] teaches away from the recited invention. Here, we find Appellants' argument to be unpersuasive of error in the Examiner's initial showing of obviousness. We find paragraph [0113] teaches the public/private key pair, and it would have been further apparent to one skilled in the art that the public or private key would have been used in various ways depending upon the desired source and destination of the communication. Here, the claim language merely states an "association" of the least one private key with the digital safe deposit account. If a private key is used within an electronic document with that safe deposit account there would necessarily be some

form of association. Appellants' claim language does not specify what context that claimed association is for. We find that storage or mere use is sufficient to meet the claimed invention. Therefore, we find that Appellants have not shown error in the Examiner's initial showing of obviousness.

Appellants further argue that claim 1 recites specific limitations and nowhere does the Wheeler publication disclose or suggest that its "digital signing chip or any other processor, both communicates with a plurality of ATMs and is in operative connection with a data store that includes a plurality of digital safe deposit accounts stored therein." (App. Br. 22). First, we note that Appellants' argument concerning the digital signing chip is not commensurate in scope with the claimed invention. Therefore, this argument is not persuasive of error in the Examiner's initial showing of obviousness. Furthermore, while we agree with Appellants that the Wheeler published application does not disclose the totality of Appellants' argument, it is the combination of teachings that teaches and fairly suggests the claimed invention as set forth by the Examiner. Repeatedly, Appellants' arguments include a portion of the subject matter relied upon by the secondary reference in each limitation which is argued to not be taught or suggested by each of the individual references. Such arguments are not persuasive of error since they do not address the combined teachings as set forth by the Examiner.

Appellants dispute the combination as maintained by the Examiner. (App. Br. 22). Appellants contend that neither Cohen nor the Wheeler published application includes a "teachings, suggestion, or motivation to replace the alleged digital account in the Wheeler publication with a digital safe deposit account." (App. Br. 22). Appellants further contend that

nowhere does Cohen provide a specific teaching, suggestion, or motivation to modify the alleged digital account of the Wheeler publication to include features of an online electronic lockbox and that the Examiner is relying upon hindsight reconstruction. We disagree with Appellants' contention and find that the teachings of Cohen suggest that the digital safe deposit accounts are in addition to the other accounts which Cohen teaches and fairly suggests. Therefore, we find no need to replace one account with the other account, as Appellants suggest. It is the additional feature of a digital lockbox which would have been added to the ATM of the Wheeler publication for banking services.

Again, Appellants turn to the argument that the accounts discussed in the Wheeler published application are not supported by the Wheeler provisional application and therefore are not prior art and cannot be replaced with the online electronic lockbox discussed in Cohen. We find Appellants' argument concerning a lack of teaching of an account with respect to an ATM machine to be unavailing. If money is involved, we find there would have been "accounts" otherwise there would have been no ability for the bank to track all the funds that are transacted, moved, transferred, dispensed, etc., without an account being known and used in all transactions. Therefore, we find Appellants' argument is unpersuasive of error in the Examiner's initial showing of obviousness. (This argument rivals Appellants' arguments later in the Brief that there is no teaching of a cash dispenser in an ATM machine, as taught by the Wheeler publication. Clearly, even if not expressly stated in the teachings of the Wheeler publication, that functionality would also be taught or fairly suggested since it is one of the basic core functions of the ATM machine since its inception.

Additionally, the Wheeler publication clearly teaches (at page 13) the presence of a cash dispenser 668.

Appellants further argue that the combination does not disclose or suggest that the claimed "computer processor is operative responsive to at least one of the ATMs to cause a digital signature to be produced for an electronic document responsive to the private key associated with one of the digital safe deposit accounts." (App. Br. 23). Appellants contend that in an exemplary embodiment the recited computer processor in claim 1 corresponds to a "server." (App. Br. 23). Here, Appellants' argument is not commensurate in scope with the express language of independent claim 1 since a server is not recited in independent claim 1.

With respect to independent claim 1, Appellants contend that it is not clear from the Office action which elements in the Wheeler publication correspond to the recited computer processor in independent claim 1. (App. Br. 23). Appellants further contend that the computer processor in independent claim 1 corresponds to a "server that is operative to communicate with a plurality of ATMs." (*Id.*) Again, Appellants' argument is not commensurate in scope with the express language of independent claim 1 wherein independent claim 1 does not recite a "server" as the computer processor.

The Examiner relies upon the teachings of the processor located in the Smartcard which stores the private key for encryption in the Wheeler publication as the claimed "computer processor." (Ans. 49-50). As a further extension of the Examiner's application of the prior art teachings, we further note that with the combination of the Wheeler publication with the teachings of Cohen regarding digital safe deposit accounts/lockboxes, it would have

been readily apparent to those skilled in the art that the secure data stored on the Smartcard could have similarly be stored in the safe deposit account/lockbox which Cohen teaches to be stored at a personal computer or on a server, as discussed above.

Furthermore, the language of independent claim 1 does not recite sufficient limitations to require any specific interpretation or put in context that the claimed computer processor is a "server." Therefore, Appellants' argument at pages 23-24 of the Brief is not persuasive of error in the Examiner's initial showing of obviousness of independent 1.

Appellants further contend that the computer processor on the card cannot correspond to the recited "computer processor" because nowhere does the Wheeler publication disclosure suggest that the computer processor is in operative connection with data stored that "includes a plurality of digital safe deposit accounts stored therein, wherein each of the digital safe deposit accounts is associated with at least one private key." (App. Br. 24). We disagree with Appellants and find that a Smartcard can hold information concerning a single account or multiple accounts for the same user/account holder wherein there could be one private key or multiple private keys depending upon the user's preference. Therefore, Appellants' argument does not show error in the Examiner's initial showing of obviousness of independent claim 1.

Appellants also argue that the Wheeler publication discloses that "public keys (not private keys) are associated with accounts" and thus teaching the private keys are stored on individual cards or other devices so that the Wheeler publication explicitly teaches away from the apparatus as recited independent claim 1. (App. Br. 24). We disagree with Appellants,

as discussed above, wherein the language of independent claim 1 is broad enough for the Examiner's use of the Smartcard where the private keys are thereon with associated account information. Furthermore, as discussed above, the Wheeler publication in combination with the teachings of Cohen with respect to safe deposit boxes/accounts and storage on a personal computer or server would have readily suggested to those skilled in the art that the private key stored on the Smartcard could be similarly stored in the safe deposit account/lockbox.

Since we found all of Appellants' arguments to be unpersuasive of error in the Examiner's initial showing of obviousness, we will sustain the rejection of independent claim 1.

In response to Appellants' contentions that the cited paragraphs of the published application are not supported by the provisional application, the Examiner notes at page 45 of the Answer that the parent application serial number 09/189,159 (now US Patent No. 6,820,202 which was filed on November 9, 1998) additionally supports the Examiner's position that the cited subject matter was known in the art at the time of Appellants' invention. (Ans. 44-45). We agree with the Examiner's finding that those portions of the Wheeler patent cited by the Examiner support what was known in the electronic banking art at the time Appellants' invention was filed. Since the published application does not expressly claim priority based upon the "parent application," the Examiner can not rely upon that date to establish priority. We do note that the Wheeler patent evidences the state of the pertinent prior art at the time the provisional application was filed to establish what was known to those skilled in relevant electronic banking art.

With respect to dependent claim 2, again, Appellants contend that the teachings of the Wheeler publication do not qualify as prior art. (App. Br. 25-27). As discussed above, we do not find Appellants' argument persuasive of error in the Examiner's initial showing of this combination of the Wheeler publication and Cohen. Furthermore, Appellants do not address the merits of the rejection with respect to the Cohen reference which is relied upon to teach and fairly suggest the use of digital safe deposit accounts to store electronic documents received in an electronic banking environment from an input/output device. Therefore, Appellants have not shown error in the Examiner's initial showing of obviousness of dependent claim 2, and we will sustain the rejection of dependent claim 2.

With respect to dependent claim 3, Appellants contend that the teachings of Cohen do not teach or suggest a computer processor that is operative to retrieve an electronic document from a data store and send the electronic document to an ATM machine. (App. Br. 27). We disagree with Appellants' contention and find that the Examiner's reliance upon the teachings of Cohen when embodied in the ATM system of the Wheeler publication would have fairly suggested a computer processor that is operative to retrieve an electronic document from a data store and send the electronic document to an ATM machine. Cohen clearly suggests the storage and access of a user's important documents and presentation to the user for self access or for presentation to third parties. For third parties to be presented with the electronic document, it would have to be retrieved from storage and sent to the recipient. In Cohen, the recipient would most likely be the recipient's computer, but in the ATM system of the Wheeler publication, the input/output devices are generally ATM or banking

machines. Therefore, we find that Appellants' argument is unpersuasive of error in the Examiner's initial showing of obviousness of claim 3.

With respect to Appellants' arguments concerning the remainder of the claims which depend from independent claim 1, Appellants reiterate the claim limitations and assert that the teachings of the Wheeler publication do not teach or suggest the claim features and furthermore that the Wheeler publication is not prior art since it is not supported by the Wheeler provisional application. As discussed above, we do not find Appellants' arguments to be persuasive of error in each of these discussions from pages 28-36 of the Brief. Furthermore, we find Appellants' dependent claims to merely set forth obvious variations of the ATM environment, storage, retrieval, and encryption/decryption security of the data. Appellants have presented no evidence that these modifications to the base system in the combined device were "uniquely challenging or difficult for one of ordinary skill in the art" or "represented an unobvious step over the prior art." *Leapfrog*, at 1162 (citing *KSR*, 127 S. Ct. at 1740-41). Furthermore, Appellants cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. Therefore, we sustain the rejection of these dependent claims.

With respect to independent claim 27, Appellants contend that the Wheeler provisional application does not disclose an electronic message which is transmitted to a card by an ATM for digitally signing by a card using a private key retained in the card and that the Wheeler publication is not supported by the Wheeler provisional application and therefore the Wheeler publication is not prior art. (App. Br. 36-37). From our review of the portions of the Wheeler provisional application cited by the Examiner

and the totality of the Wheeler provisional application, we agree with the Examiner that the Wheeler provisional application amply supports those portions of the Wheeler publication relied upon, as discussed above with regard to the applied subject matter.

Appellants further contend that even if the Wheeler publication is prior art, the Wheeler publication and Cohen do not disclose or suggest all of the features and relationships recited in independent claim 27. Appellants then list all of the limitations of independent claim 27. Appellants further contend that the Office action does not state which elements of the Wheeler publication correspond to the respective elements recited in independent claim 27 (App. Br. 37-38). Appellants also submit that nowhere does the Wheeler publication disclose or suggest that these steps are carried out by the described card or any other device (*Id.*). We find Appellants' argument to be a general argument which is not commensurate in scope with Appellants' express claim language. Furthermore, Appellants' assertion that none of the elements of the claim are taught or suggested by either reference clearly shows that Appellants are not addressing the combination of teachings as applied by the Examiner and therefore cannot show error in the Examiner's initial showing of obviousness.

Furthermore, the Examiner need not show what structure or device carries out the claimed functions since no hardware beyond an automated transaction machine is expressly recited in the generic "method" without any further context of independent claim 27.

With respect to step (a), Appellants contend that nowhere does the Wheeler publication or Cohen disclose or suggest receiving a request from an automated transaction machine to digitally sign an electronic document

visually displayed by an automated transaction machine. Appellants further contend that nowhere does the Wheeler publication disclose or suggest an electronic message transmitted by the ATM (660) to the card (650) is ever visually displayed by the ATM. (App. Br. 38). We disagree with Appellants' contention, and find that the Wheeler publication suggests that the electronic document is visually displayed and signed by the ATM. Furthermore, the communication labeled "Aadsbrnd" in the provisional application in the first paragraph discusses some sort of viewing what was signed. Furthermore, the brokerage account discussion starting in paragraph [0194] at page 15 of the Wheeler publication for buying and selling a specific security using a PDA requires the account holder to confirm such a request by digitally signing the request with the PDA. We additionally find this to be merely one example of an e-commerce transaction that displays electronic documents and transactions when authenticating and signing. Therefore, we find Appellants' argument to be unpersuasive of the error in the Examiner's initial showing of obviousness of independent claim 27. We find Appellants' arguments with respect to steps (b)-(d) to similarly be unpersuasive of error.

Appellants further contend that neither Cohen nor the Wheeler publication includes a teachings, suggestion, or motivation to "replace the alleged digital account in the Wheeler publication with a digital safe deposit account." (App. Br. 39-40). As discussed above, we do not find the argument concerning hindsight and teaching, suggestion, or motivation to be persuasive of error in the initial showing of obviousness including the stated motivation in the Answer at page 15. Therefore, we will sustain rejection of independent claim 27.

With respect to dependent claims 28 and 29, we find present similar arguments which we found to be unpersuasive of error, as discussed above. Therefore, we will sustain rejection of dependent claims 28 and 29.

With respect to independent claim 33, Appellants contend that the portions of the Wheeler publication relied upon by the Examiner are not supported by the Wheeler provisional application and therefore the Wheeler publication is not prior art against the claimed invention. As discussed above, from our review of the relied upon the portions of the Wheeler publication and the totality of the Wheeler provisional application, we find ample support for those portions relied upon by the Examiner, as discussed above. Therefore, we find Appellants' argument to be unpersuasive of the error in the Examiner's initial showing of obviousness. Appellants further contend that even if the Wheeler publication is prior art, the Wheeler publication and Cohen do not disclose all of futures and relationships recited in independent claim 33. (App. Br. 43-45). We disagree with Appellants as discussed above.

Appellants further contend that the Examiner admits that the Wheeler publication does not disclose a server that carries out to recited steps and Appellants disagree with the Examiner's reasoned conclusion that it would have been obvious to carry out the steps on a server instead of a Smartcard based on the suggestion in Cohen. (App. Br. 45).

First, independent claim 33 merely sets forth a "method" with the only structure recited therein to be a "server." Here, we find the method disclosed by the combination of the Wheeler publication with Cohen to be functionally processed by any computer system, whether it is a Smartcard, server, PDA, laptop computer, personal computer, or any computer with processing

ability. Here, the label "server" does not provide any structure to limit the generic "method" in independent claim 33. Independent claim 33 does not even recite an ATM with which to interpret the claim language to give some context. Therefore, we find Appellants' argument unpersuasive of error in the Examiner's initial showing of obviousness of independent claim 33.

Second, we agree the Examiner's reasoned conclusion that Cohen suggests the use of a server computer that would have been readily apparent to one of ordinary skill in the art at the time the invention was made. (Ans. 71).

Appellants argue that in the Wheeler publication a private key is stored in the Smartcard (650), not in a server and the Wheeler publication does not disclose or suggest that its private key is ever stored in the at least one data store of a server and correlated relation with the data associated with the financial account. Here, Appellants merely address each individual teaching of the references without addressing the rejection as applied by the Examiner over the combination of teachings. Therefore, Appellants' arguments are unpersuasive of an error in the Examiner's initial showing of obviousness of independent claim 33.

Appellants further contend that the combination of teachings would destroy the utility or advantage of the device shown in the prior art, but Appellants do not provide an analysis of how the utility or advantage would be "destroyed." (App. Br. 46-47). Therefore, Appellants' argument does not show error in the Examiner's initial showing of obviousness. Appellants argue that the menu displayed by ATM of the Wheeler publication does not inherently require a message to be displayed by the ATM which has been or will be digitally signed. (App. Br. 47). Appellants further argue of

inherency. (App. Br. 47-48). However, the Examiner has based the rejection upon obviousness. Therefore, Appellants' arguments are unpersuasive of an error in the Examiner's initial showing of obviousness over the combination of the Wheeler publication and Cohen.

Again, Appellants contend that the Wheeler publication is not supported by the Wheeler provisional application and hence is not prior art. The further contend that there is no prior art teaching, suggestion, or motivation cited for modifying the Wheeler publication in view of Cohen so as to produce the claimed invention. As discussed above, we find Appellants' argument unpersuasive of error in the Examiner's initial showing of obviousness, and we will sustain rejection of independently claim 33.

With respect to dependent claims 34, 35, 36, 37, 38, and 39, Appellants set forth similar arguments reciting the limitations of the claims and general arguments that the limitations are not taught or fairly suggested by the applied references. We find Appellants' arguments unpersuasive of error in the Examiner's initial showing of obviousness, as discussed above. Therefore, we will sustain the rejection of dependent claims 34-39.

With respect to claim 41, the claim recites a computer readable media bearing instructions which carry out the method steps recited in independent claim 33. Rather than being a dependent claim which further limits the base claim, claim 41 is directed to a different statutory class of invention which does not limit the base method. We leave it to the Examiner and Appellants to correct this informality. With respect to the merits, Appellants rely upon the same arguments advanced with respect to independent claim 33. (App. Br. 55). We found those arguments unpersuasive of error with respect to

independent claim 33, and we similarly find them unpersuasive of error with respect to the same method embodied on computer readable media.

With respect to dependent claim 7, Appellants contend that nowhere do the applied references disclose or suggest the recited features in dependent claim 7, and nowhere does the Randle reference or any of the other applied references disclose or suggest a computer processor that is operative to cause the digital signature and at least one of the digital certificate associated with the one digital safe deposit account to be attached to the electronic document. (App. Br. 56). We find Appellants' generalized contention to be unpersuasive error in the Examiner's initial showing of obviousness. While Randle teaches the use of a digital certificate related to an account to gain access to resources, we find no facet of the instant claimed use of the digital certificate that would have been unobvious to one skilled in the art at the time the invention was made. Therefore, we find Appellants' argument unpersuasive of error in the Examiner's initial showing of obviousness.

With respect to dependent claim 12, Appellants rely upon similar arguments advanced with respect to dependent claim 7 which we found unpersuasive of error. Similarly, we find Appellants' arguments unpersuasive of error in the Examiner's initial showing of obviousness dependent claim 12.

With respect to dependent claim 13, Appellants argue that nowhere does the Wheeler publication nor any of the other applied references disclose or suggest a computer processor is operative to store a financial account number or any other account number received from an ATM, in a digital safe deposit account. While this is true, since the Wheeler publication does

not teach digital safe deposit accounts, we find that, in combination with the teachings of Cohen concerning digital safe deposit accounts and storage of electronic information therein, it would have been readily apparent to those skilled in the art at the time the invention was made that account numbers may be stored in the digital safe deposit account as the Wheeler publication teaches that the account numbers are stored in the Smartcard. Therefore, we find Appellants' argument to be unpersuasive error in the Examiner's initial showing of obviousness.

With respect to dependent claim 14, as discussed with respect to dependent claim 13, we find the teachings of Cohen concerning safe deposit accounts and usage thereof to fairly suggest the claimed invention. Therefore, we do not find Appellants' argument persuasive of error in the Examiner's initial showing of obviousness.

With respect to dependent claim 40, as discussed above with respect to dependent claim 12, we find Appellants' argument unpersuasive of error in the Examiner's initial showing of obviousness of dependent claim 40.

With respect to dependent claim 17, Appellants contend that nowhere does Meurer disclose or suggest assessing a digital signature processing fee. (App. Br. 60-61). While we agree with Appellants regarding the teachings of Meurer with respect to surcharges and interchange fees in dispensing cash from an ATM machine, we nevertheless find the teachings of Meurer sufficient to render obvious the charging of fees for services performed. Here, we find that an artisan possessing common sense would have found it obvious to assess fees for various services which are provided by a service provider. Therefore, we find Appellants' argument unpersuasive of error in the Examiner's reliance upon the teachings of Meurer in combination with

the teachings of the Wheeler publication and Cohen to show the obviousness of dependent claim 17.

With respect to dependent claim 18, Appellants contend that nowhere does the Wheeler publication disclose or suggest that the account number sent in the message from an ATM is ever used to assess a digital signature processing fee. Again, while we agree with Appellants since the Wheeler publication discloses processing fees, we nevertheless note that Appellants must show error in Examiner's proffered *prima facie* case that is based on the *combination* of the cited references. We find Appellants' argument to be unpersuasive of error in the initial showing of obviousness, as discussed above.

With respect to independent claim 20, again, Appellants argue that the Wheeler provisional application does not support the portions of the Wheeler publication relied on in the Office action to reject claim 20. As discussed above, we find ample support in the Wheeler provisional application to support those portions of the Wheeler publication relied upon to reject the claim. Appellants further contend that even if the Wheeler publication were prior art, nowhere does the reference disclose or suggest the claimed limitations and Appellants further contend that the action does not state which elements of the Wheeler publication correspond to the expected elements or what carries out the steps. (App. Br. 62-63).

We find the preamble of independent claim 20 sets forth a generic "method" and the only structure set forth in the claim is an automated transaction machine as an input device. Therefore, we find the claim does not set forth any specific structure to carry out the steps. Thus, Appellants' argument is not commensurate with the express language of independent

claim 20 and does not show error in the Examiner's initial showing of obviousness. Appellants further contend that nowhere does the Wheeler publication disclose or suggest accessing a private key associated with a financial account number received from an automated transaction machine. Appellants argue that while the Wheeler publication teaches that the account number could be used to access the public key, nowhere does it teach that it could be used to access the private key. (App. Br. 64). Here, we find that skilled artisans would have readily appreciated that with a teaching of accessing any portion of a public/private key pair, it would have been obvious to similarly store either one of the keys depending on the desired use thereof. Here, the claim sets forth no field of endeavor, and we find that the teachings of the Wheeler publication would have readily suggested the storage of security related information associated with an account number or other account identifying indicia as done on the Smartcard. Therefore, we find Appellants' argument unpersuasive of error in the Examiner's initial showing of obviousness. Appellants further argue that nowhere does the Wheeler publication disclose or suggest enabling an electronic document displayed by an automated transaction machine to be digitally signed with the private key. (App. Br. 64-66). As discussed above, we find that the Wheeler publication fairly suggests the display of electronic documents and signing of the private key. Therefore, we find Appellants' argument unpersuasive of error in the Examiner's initial showing of obviousness.

With respect to dependent claim 21, Appellants argue nowhere does the Wheeler publication disclose or suggest receiving and verifying a password received from an automated transaction machine prior to enabling an electronic document displayed by the automated transaction machine to

be digitally signed with the private key. (App. Br. 66). We find the teachings of the Wheeler publication concerning an ATM machine to readily teach and fairly suggest the use of receiving a password or pin number and verifying that pin number associated with a financial account number prior to allowing any functions (account manipulation or cash dispensing). Therefore, we find Appellants' argument unpersuasive of error in the Examiner's initial showing of obviousness, and to sustain the rejection of dependent claim 21.

With respect to dependent claim 23, Appellants contend that while the Wheeler publication indicates that data fields in an electronic communication may be stored, nowhere does the Wheeler publication disclose or suggest that such communications are stored in association with a digital safe-deposit account in association with the financial account number. (App. Br. 66-67).

Appellants again contend that the Wheeler publication is not prior art as argued previously. We find the Wheeler publication to be amply supported by the Wheeler provisional application, as discussed above. Furthermore, we find Appellants' argument unpersuasive of error in the Examiner's initial showing. Here, the Examiner has not relied upon the teachings of the Cohen reference to evidence a well-known use of an electronic safe deposit account. Yet, we find that the teachings of the Wheeler publication to be adequate to teach and fairly suggest the storage of electronic information associated with an account. Appellants have identified no specialized definition for the claimed "digital safe deposit account" (claim 23) nor have Appellants identified any characteristics of the electronic document which is stored. Therefore, we find that the teachings

of the Wheeler publication disclose and fairly suggest the storage of some information concerning an account which was displayed and signed with a private key associated with the financial account number. Therefore, we find Appellants' argument unpersuasive of error in the Examiner's initial showing of obviousness.

With respect to dependent claim 25, Appellants argue that the Wheeler publication is not prior art. (App. Br. 68). The Examiner identifies paragraph [0172] which expressly states the use of a time/date stamp. Rather than address the merits of the rejection with an express teaching, Appellants refer to the priority document portion (Wheeler provisional application) which the Examiner identified to support this element. Appellants contend that the provisional application merely states that a unique message includes a "date/time." (App. Br. 68). We find this teaching to amply support paragraph [0172] and paragraph [0115] which also states a time and date stamp. Appellants claim language merely sets forth "enabling the electronic document to be digitally time stamped" (claim 25), and provides no other limitation regarding the content or structure of the time stamp. Therefore, we find Appellants' argument unpersuasive of error in the Examiner's initial showing of obviousness.

With respect to dependent claim 26, Appellants argue that nowhere does the Wheeler publication disclose or suggest both dispensing cash from an automated transaction and enabling an electronic document displayed by the automated transaction machine to be digitally signed. (App. Br. 68). As discussed above, we find that the automated transaction machine in the Wheeler publication to teach and fairly suggest dispensing cash since this is one of the basic functions of the ATM machine. Therefore, we find

Appellants' argument unpersuasive of error in the Examiner's initial showing of obviousness.

With respect to dependent claim 31, Appellants rely upon the same argument that the provisional application does not support the portions relied upon in the Wheeler publication and further that Wheeler does not inherently require the message to be displayed. (App. Br. 69-72). As discussed above, we find Appellants' argument to be unpersuasive of error, and find that the Wheeler provisional application amply supports those portions of the Wheeler publication. Therefore, we find Appellants' argument unpersuasive of error in the Examiner's initial showing of obviousness.

With respect to dependent claims 22 and 24, Appellants rely upon the same arguments concerning the use of a certificate related to an account and assessing a processing fee. Again, we do not find Appellants' arguments to be persuasive of error in the Examiner's initial showing of obviousness.

V. CONCLUSION

For the aforementioned reasons, we found that the portions of the Wheeler publication are amply supported by the teachings generally recited in the Wheeler provisional application and therefore the Wheeler publication is entitled to the priority date thereof for the relied upon subject matter. Additionally, we found all of Appellants' arguments to be unpersuasive of error in the Examiner's initial showing of obviousness.

VI. ORDER

We affirm the obviousness rejections of claims 1-41.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

rwk

RALPH E. JOCKE
walker & jocke LPA
231 SOUTH BROADWAY
MEDINA, OH 44256